

52. (Once Amended) An apparatus comprising:

(a) a baby bottle, said baby bottle comprising a nipple and a cover for said nipple, said nipple comprising a top with an orifice in said top, said cover including a sealing element therein for sealing said orifice at said top of said baby bottle nipple;

(b) said baby bottle further comprising a skirt, said skirt comprising a protective element for placement on the bottom of said baby bottle to protect against shocks to the bottom of said baby bottle.

53. (New) An apparatus as claimed in Claim 16, wherein said apparatus further comprises a baby bottle.

### Response

Receipt is acknowledged of the Office Action dated September 25, 2001 in the above-captioned matter. A three month extension of the time provided for response and reconsideration of the application are respectfully requested. Small entity status is hereby claimed. A check for \$469 in payment of the small entity fees for the extension (\$460) and the new dependent claim (\$9) is enclosed. The Commissioner is hereby authorized to debit any additional fees that may be required from Deposit Account No. 50-1604, and is further authorized to credit any overpayments thereto.

### Priority Claim to Provisional Application

The present application claims the priority of U.S. Provisional Application Serial No. 60/152,655 filed September 7, 1999, as set forth on the first page of the specification and in the declaration. Acknowledgment of this priority claim and its entry into the file are respectfully requested.

### Rejections under §§102, 103 and 112

In the Office Action, the Examiner rejected the application under §§102 and 103 based on the disclosures of Pillado (U.S. Patent No. 6,092,680) and Shefflin (U.S. Patent No. 5,878,898). With respect to the §102(a) rejection based on Pillado, Applicant notes that Pillado is not available as a reference under Section 102(a), due to the fact that Pillado was not issued until July 25, 2000 – which is after the effective filing date of the present application. Even taking just the priority date of the provisional application, the effective filing date of the present application is September 7, 1999, which is before the publication date of the Pillado reference. As a result, Pillado is not art under §102(a). *See*, MPEP 706.02(a)III (“For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant’s own work”).

However, even in the event that the Pillado reference were cited against the present application under §102(e), neither the Pillado reference nor Shefflin are prior art to the present invention.

Attached please find a Section 131 declaration by the inventor of the subject matter of all of the pending claims. Pursuant to Section 131, when a claim of an application is rejected under §102(a) or §102(e), the inventor of the subject matter of the rejected claim may submit a declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. *See*, 37 C.F.R. §1.131 and MPEP §715. As set forth in the attached declaration, the present invention was reduced to practice before February 16, 1996, i.e. prior to the effective dates of both the Pillado and the Shefflin references. Exhibits in the form of invoices and drawings showing Applicant’s prior invention are attached to the declaration. The declaration verifies and attests to the fact that the dates of the invoices and drawings are prior to February 16, 1996, as required by the MPEP

and CFR.<sup>1</sup> As a result, it is respectfully requested that both rejections be withdrawn.

With respect to the §112 rejections of Claims 6, 15, and 16, the invention of those particular claims only recite a cover for a baby bottle. Claims 6, 15 and 16 refer to the nipple as an environmental element (something the invention is used with), but do not positively recite the nipple as part of the claim. As a result, the words “said nipple” are never used in those claims. It would infringe Claims 6, 15, and 16 whether the cover were provided separately (as a part for use with a baby bottle) or whether the cover were provided along with the bottle. In other words, even providing the claimed cover alone would infringe Claims 6, 15, and 16.

Further claims specifically recite the entire baby bottle also. *See e.g.*, Claim 8 and new Claim 53. Providing a baby bottle with the claimed cover would infringe Claims 8 and 53. For example, providing a baby bottle having the cover attached would infringe those claims. Or, providing the baby bottle and the cover together as a set would also infringe those claims.

Claims 51 and 52 have also been amended. As amended, the claims now recite a baby bottle with a cover having a sealing element as a mandatory element of both claims.<sup>2</sup> As a result, both claims are fully patentable in view of the attached §131 declaration. Claim 51 recites the embodiment wherein the baby bottle also has the cap and handle of the invention. Claim 52 recites the embodiment wherein the baby bottle also the skirt of the invention.

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<sup>1</sup> The dates listed on the invoice and drawings have been blocked off, as permitted by the MPEP, with the matter of the dates addressed in the declaration. *See*, MPEP §715.07 under “Establishment of Dates” (8<sup>th</sup> Ed. August 2001). Confidential information such as pricing has been blocked off as well.

<sup>2</sup> It is to be noted that the terms comprising, having and including are all used interchangeably in the amended claims as open terms.

In view of the above, it is believed that all of the claims of the application are fully allowable.

Favorable action on the application is respectfully requested and believed fully warranted.

Dated: March 25, 2002

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "m. e. cohen", followed by a horizontal line.

Morris E. Cohen (Reg. No. 39,947)  
1122 Coney Island Avenue, Suite 217  
Brooklyn, New York 11230  
(718) 859-8009 (telephone)  
(718) 859-3044 (facsimile)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re: Application of: Hakim Patent Application

Serial No.: 09/656,289

Art Unit: 3727

Examiner: Tri Mai

Filing Date: Sept. 6, 2000

For: = Baby Bottles with  
Sealing Icons

Attorney Docket No.: 4009.016

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Commissioner for Patents  
Washington, D.C. 20231

**Marked-Up Amended Claims**

For the Examiner's reference and pursuant to 37 C.F.R. 1.121, a marked-up version of the amended claims is provided as follows:

51. (Once Amended) [A baby bottle comprising at least two elements selected from the group consisting of] An apparatus comprising:
- (a) a baby bottle, said baby bottle comprising a nipple and a cover for said nipple, said nipple comprising a top with an orifice in said top, [a cover for a baby bottle having a nipple], said cover including a sealing element therein for sealing [the] said orifice at [the] said top of [the] said baby bottle['s] nipple;
- (b) said baby bottle further comprising a cap [for a baby bottle] and a handle, wherein said cap contains a recess therein for receiving a portion of [a] said handle in a mating relationship [;] \_.

[(c) a handle for a baby bottle having a cap, wherein said handle is shaped for attaching to the cap of the baby bottle in a mating relationship; and

(d) a skirt for a baby bottle, said skirt comprising a protective element for placement on the bottom of the baby bottle to protect against shocks to the bottom of the bottle.]

52. (Once Amended) [A baby bottle comprising at least three elements selected from the group consisting of] An apparatus comprising:

(a) a baby bottle, said baby bottle comprising a nipple and a cover for said nipple, said nipple comprising a top with an orifice in said top, [a cover for a baby bottle having a nipple], said cover including a sealing element therein for sealing [the] said orifice at [the] said top of [the] said baby bottle['s] nipple;

[(b) a cap for a baby bottle, wherein said cap contains a recess therein for receiving a portion of a handle in a mating relationship;

(c) a handle for a baby bottle having a cap, wherein said handle is shaped for attaching to the cap of the baby bottle in a mating relationship; and]

[d)] (b) said baby bottle further comprising a skirt [for a baby bottle], said skirt comprising a protective element for placement on the bottom of [the] said baby bottle to protect against shocks to the bottom of [the] said baby bottle.

Dated: March 25, 2002

Respectfully submitted,



Morris E. Cohen (Reg. No. 39,947)  
1122 Coney Island Avenue, Suite 217  
Brooklyn, New York 11230  
(718) 859-8009 (telephone)  
(718) 859-3044 (facsimile)